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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,777	01/13/2006	Jochim Luthle	Le A 36 131	5263
35969 7590 07/27/2010 Barbara A. Shimei Director, Patents & Licensing Bayer HealthCare LLC - Pharmaceuticals 555 White Plains Road, Third Floor Tarrytown, NY 10591				
			EXAMINER MABRY, JOHN	
			ART UNIT 1625	PAPER NUMBER
			MAIL DATE 07/27/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/516,777

Applicant(s)

LUITHE ET AL.

Examiner

JOHN MABRY

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15, 12, 13 and 19 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Applicant's Remarks

Applicant is respectfully reminded that it is required that all claims be amended to elected group in order to be considered for allowability.

Election/Restriction was made final on January 15, 2010.

Applicant's response on May 14, 2010 filed in response to the Office Action dated January 15, 2010 has been received and duly noted.

In view of this response, the status of the rejections/objections of record is as follows:

Status of the Claims

Claims 1-11 and 15 are pending and rejected.

Claims 14 and 16-18 have been cancelled.

Claims 12, 13 and 19 are directed towards non-elected subject matter.

Claim Rejections Withdrawn

35 USC § 112 Rejection(s)

The 112-1st rejection of claims 1-11 and 15 regarding the terms "solvate and hydrate" have been overcome in view of Applicant's amendment.

The 112-1st rejection of claims 1-11 and 15 regarding the scope of enablement have been overcome in view of Applicant amending the claims.

Claim Rejections - 35 USC § 103

Rejection of claims 1-9 and 15 under 35 U.S.C. 103(a) as being unpatentable over 10/500,096 are withdrawn in view of Applicant's remarks.

Claim Rejection Maintained

Obviousness-Type Double Patenting Rejection(s)

Claims 1-9 and 15 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 11, 16-21 and 23 of copending Application No. 10/500,096. US 10/500,096 (US 20050119325 - now US Patent 7,732,477) has since been allowed.

Applicant requested an abeyance of the provisional double patenting rejecting until such time that allowable subject matter is known in the present application at issue. The most current amended claims are not in condition for allowance.

Claims 1-9 and 15 are now rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 7,732,477. Although the conflicting claims are not identical, they are not patentably distinct from each other because the following.

The instant application claims compounds and pharmaceutical compositions of Formula I, wherein A=S, O and ring B = benzo, E=phenyl, R3=H and R4=H.

10/500,096 claims compounds and pharmaceutical compositions of Formula I, wherein A=S, O and ring B = benzo where benzo is substituted by benzo. The substituted benzo represents E=phenyl and R4=H of the instant application.

The closest definition found in the Specification of 10/500,096 regarding the term "benzo" is found on page 6 of its Specification where the term phenylcarbonyl radical corresponds to benzoyl radical. In essence, 10/500,096 equates the term benzo to mean phenyl. In the chemical community, the term "benzo" is commonly referred and related to the term "phenyl".

A properly executed Terminal Disclaimer is required to overcome rejection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

Applicant is respectfully reminded that it is required that all claims be amended to elected group. Examiner also warns Applicant not to introduce new matter when amending.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Mabry, PhD whose telephone number is (571) 270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's primary examiner can be reached at (571) 272-0684, first, or the Examiner's supervisor, Janet Andres, PhD, can be reached at (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/John Mabry/
Examiner
Art Unit 1625

/Rita J. Desai/
Primary Examiner, Art Unit 1625